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### REMARKS

The Applicant has amended claims 1, 4, 8, 20, 29, 35 and 38. These amendments are submitted to be completely supported by the application as originally filed and to add no new matter.

#### Species Election

The Applicant hereby affirms the provisional election of species II of the container (Figures 10-15), species A of the apparatus (Figure 7) and species b of the pivot joint (Figure 19) as identified in the Office Action.

The Examiner has indicated that claims 1-16, 19-24, 28-31 and 35-37 read on the elected species and has not considered claims 17, 18, 25-27, 32-34 and 38. However, the Applicant submits that claims 1-16, 19-24, 26-31 and 34-38 read on the elected species.

The Applicant submits further that:

- at least claims 1, 28, 29, 34 and 38 are generic to the container species I, II and III identified in the Office Action;
- at least claims 1-14, 19-22, 26-29 and 34-38 are generic to the container species I and II identified in the Office Action;
- at least claims 23, 24, 30 and 31 are generic to the container species II and III identified in the Office Action;
- all of the currently pending claims are generic to the apparatus species A and B identified in the Office Action;
- and at least claims 1-16, 19-25 and 28-38 are generic to the pivot joint species a and b identified in the Office Action.

#### Claims 1-4 and 8

The Examiner has raised the combination of US Patent No. 2,922,527 (Finn) and US Patent No. 6,644,482 (Ku) in connection with claims 1-4 and 8. The Applicant submits that claims 1-4 and 8, as amended, patentably distinguish the combination of Finn and Ku.

As understood by the Applicant, Finn discloses a holder for a plurality of phonograph records, in which individual records are stored in corresponding individual storage members (54). Each individual storage member (54) is formed from a pair of like

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discs (56) held in spaced relationship at their upper end by an integral apertured ear (58) and at their lower end by integral shoulder (60) to form a storage chamber (62). A pair of arcuate closure members (70) embrace the perimeter edges of discs (56) and are pivotally connected at their lower ends to shoulder (60). Arcuate closure members (70) pivot between closed positions, where they embrace the perimeter edges of discs (56) to close storage chamber (62) and open positions, where they are pivoted away from the perimeter edges of discs (56) to permit insertion/removal of a record to/from storage chamber (62). Storage member (54) is coupled to a rod (44) which penetrates the aperture in ear (58), such that the entire storage member (54) including both discs (56) may be pivoted about the rod axis.

The Examiner has expressed the view that Finn discloses the claim 1 feature of a base (56) and a lid (56) coupled to the base by a pivot joint for releasably housing an optical disc between the base and the lid, the pivot joint permitting pivotal motion of the lid relative to the base. The Applicant respectfully submits that the Examiner has misinterpreted this aspect of Finn. Finn does disclose a pair of discs (56) for housing phonograph records therebetween. However, Finn does not teach or disclose a pivot joint between discs (56) for pivotal motion of discs (56) relative to one another. In contrast, Finn describes discs (56) as being "held in spaced relationship by an integral apertured ear 58 projecting from the perimeter at the top and an integral shoulder 60 oppositely disposed from ear 58 at the bottom" (col. 2, ln. 35-39). The Finn discs (56) form an integral, unitary storage chamber (62) and are not capable of pivoting relative to one another. Accordingly, the Finn discs (56) do not exhibit the features of the base and the lid recited in claim 1.

For these reasons, Finn does not teach or suggest the claim 1 feature of "a lid coupled to the base by a pivot joint for releasably housing an optical disc between the base and the lid, the pivot joint permitting pivotal motion of the lid relative to the base about a pivot axis that is substantially orthogonal to a plane of the disc housed between the base and the lid ... wherein the base comprises a generally flattened base portion disposed to protect a first planar surface of the disc housed between the base and the lid and the lid comprises a generally flattened lid portion disposed to protect a second, opposing planar surface of the optical disc housed between the base and the lid".

Ku fails to remedy this deficiency. None of the optical disc hanging units described by Ku include a lid coupled to a base by a pivot joint as recited in claim 1.

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Based on this reasoning, the Applicant submits that claim 1 patentably distinguishes the combination of Finn and Ku. Claims 2-4 and 8 depend from claim 1 and are submitted to patentably distinguish the combination of Finn and Ku for at least this reason.

Claims 5-7, 9-15, 19-22, 28 and 29

The Examiner has raised the combination of Finn, Ku and US Patent No. 5,848,688 (Paloheimo) in connection with claims 5-7, 9-15, 19-22, 28 and 29. The Applicant submits that these claims patentably distinguish the combination of Finn, Ku and Paloheimo.

Paloheimo fails to remedy the above-discussed deficiency with Finn and Ku. Paloheimo discloses a connector configuration that allows several identical covers to be joined together on top of each other to form a cover system. The connector includes a cylindrical portion which, when mated to an identical cylindrical portion on another cover, permits a pivotal connection between covers. As disclosed in Figures 1 and 2 and the accompanying description at col. 2, ln. 35-45, each of the Paloheimo covers has a frame with first and second mutually parallel main surfaces (1,2) which are joined together by a surrounding side surface (3) to form an enclosure for housing diskettes. The main surfaces (1,2) of the Paloheimo covers are integrally formed and are not pivotable with respect to one another. To the extent that the Paloheimo system incorporates pivot joints, such pivot joints allow pivotal motion between individual covers only and not between a base and a lid which house an optical disc therebetween as recited in claim 1.

Based on this reasoning, the Applicant submits that claim 1 patentably distinguishes the combination of Finn, Ku and Paloheimo. Claims 5-7, 9-15, 19-22, 28 and 29 depend from claim 1 and are submitted to patentably distinguish the combination of Finn, Ku and Paloheimo for at least this reason.

Claims 16, 23, 24, 30 and 31

The Examiner has raised the combination of Finn, Ku and US Patent No. 6,648,135 (Ho) in connection with claims 16, 23, 24, 30 and 31. The Applicant respectfully submits that these claims patentably distinguish the combination of Finn, Ku and Ho.

Ho fails to remedy the above-discussed deficiency with Finn and Ku. None of the optical disc storage containers described by Ho include a lid coupled to a base by a pivot joint that permits pivotal motion of the lid relative to the base about a pivot axis that is

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substantially orthogonal to a plane of the disc housed therebetween. Accordingly, claims 16, 23, 24, 30 and 31, which depend from claim 1, are submitted to patentably distinguish the combination of Finn, Ku and Ho.

Claims 35-37

The Examiner has raised the combination of Finn, Ku and Paloheimo in connection with claims 35-37. The Applicant respectfully submits that claims 35-37 patentably distinguish the combination of Finn, Ku and Paloheimo.

Claim 35, as amended, recites the combination of "a base ...", "a lid pivotally coupled to the base by a pivot joint for housing an optical disc between the base and the lid ..." and "wherein the pivot joint permits pivotal motion of the lid relative to the base about a pivot axis that is substantially orthogonal to a plane of the disc housed between the base and the lid and wherein the base comprises a generally flattened base portion disposed to protect a first planar surface of the disc housed between the base and the lid and the lid comprises a generally flattened lid portion disposed to protect a second, opposing planar surface of the optical disc housed between the base and the lid". The combination of Finn, Ku and Paloheimo do not teach or suggest these claim 35 features. As discussed above, the combination of Finn, Ku and Paloheimo fails to teach or suggest a lid that is pivotally coupled to a base by a pivot joint wherein the pivot joint permits pivotal motion of the lid relative to the base about an axis that is orthogonal to the disc housed between the lid and the base.

Accordingly, the Applicant respectfully suggests that claim 35 patentably distinguishes the combination of Finn, Ku and Paloheimo. Claims 36 and 37 depend from claim 35 and are submitted to patentably distinguish the combination of Finn, Ku and Paloheimo for at least this reason.

Claims 26-27, 34 and 38

As discussed above, the Applicant submits that claims 26, 27, 34 and 38 read on the elected species and hereby requests formal consideration of these claims. The Applicant submits that claims 26, 27, 34 and 38 are allowable at least because they depend from allowable base claims.

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Claims 17, 18, 25, 32 and 33

Claims 17, 18, 25, 32 and 33 are withdrawn pursuant to the aforementioned species election pending the allowance of a generic claim. The Applicant submits that independent claim 1 is generic to all of the species identified by the Examiner and is allowable for the reasons discussed above.

Accordingly, the Applicant submits that claims 17, 18, 25, 32 and 33 which depend from claim 1 are entitled to consideration as provided by 37 CFR § 1.141 and requests rejoinder of these claims.

Conclusions

The Applicant respectfully requests reconsideration and allowance of this application in light of the foregoing amendments and comments.

Respectfully submitted,  
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